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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO.       |
|--|-------------|----------------------|---------------------------|------------------------|
| 09/399,083   | 09/17/1999  | DAVID CALDERWOOD     | BBIC-043/A                | 1842                   |
| 7590 04/03/2007<br>GAYL B O'BRIEN<br>ABBOTT BIORESEARCH CENTER<br>100 RESEARCH DRIVE<br>WORCESTER, MA 01605-4314 |             |                      | EXAMINER<br>RAO, DEEPAK R |                        |
|  |             |                      | ART UNIT<br>1624          | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>04/03/2007   | DELIVERY MODE<br>PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/399,083

Applicant(s)

CALDERWOOD ET AL.

Examiner

Deepak Rao

Art Unit

1624

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 3/19/07. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

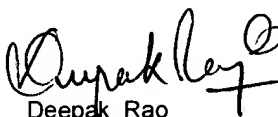
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: 52.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-8, 10, 46-47.
- Claim(s) withdrawn from consideration: 11 and 48-51.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

  
Deepak Rao  
Primary Examiner  
Art Unit: 1624

### ADVISORY ACTION

The amendment filed March 19, 2007 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and **will not be entered** because the amendment raises new issues, that require further consideration and/or search:

1. The definition of L in the proposed amendment continues to include  $-N(R)S(O)_2-$  and it has been indicated in the previous office actions that the reference teaches compounds wherein A is  $-NH SO_2-$  and therefore, the instant claims are rendered obvious over the reference teachings. Applicant has not provided any arguments or evidence to show how the instant claims overcome the rejection. The instant claims continue to be obvious over the reference teachings for the reasons provided in the previous office action(s).
2. The proposed amendment raises new issues at least under 35 USC 112, second paragraph:
  - a. The definition of L has been modified by the proposed amendment by elimination of the groups S; S(O); S(O)<sub>2</sub>; N(R)C(O); C(O)N(R), however, the claim continues to recite a 'proviso' excluding compounds wherein L is one of the above groups, see e.g., compounds having the terms 'sulfinyl'; 'sulfonyl'; 'benzamide'. As the definition of L has been modified, the claim does not contain basis for some of the compounds excluded using the proviso statement. There is insufficient basis in the claim to exclude compounds that are not positively recited in the claimed genus.

- b. Claim 47 continues to recite that 'L is  $\text{-NHC(O)-}$ ', however, there is insufficient antecedent basis for this limitation in claim 1 on which claim 47 depends from.

As amended claim 1 no longer contains the corresponding group  $\text{-N(R)C(O)-}$  as part of the definition of L.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

March 29, 2007